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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TATSUYA MITSUGI

Appeal 2009-004112
Application 09/955,197
Technology Center 2100

Decided: October 26, 2009

Before JOSEPH L. DIXON, JAY P. LUCAS, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

The Patent Examiner rejected claims 1-13. The Appellant appeals the rejected claims under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a communication network system includes a conversion/formatting server located between a content server and a portal server for converting the contents from a predetermined format to different format (Abstract).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A communication network system that can provide contents information for users by way of a communication network, said system comprising:

a contents server disposed as a source of information, for storing contents information;

one or more portal servers, responsive to a request which a user makes through communication terminal equipment, for transmitting contents information to the communication terminal equipment; and

a conversion/formatting server disposed in a communication link between said contents server and said one or more portal servers, for converting contents information which said conversion/formatting server has acquired from said contents server into exchangeable

contents information in a predetermined format, storing the exchangeable contents information in a memory, formatting the exchangeable contents information stored in said memory in the predetermined format into displayable contents information suitable for display on the communication terminal equipment in response to a request from said one or more portal servers, and transmitting the formatted contents information to one or more of said one or more portal servers.

The References

The Examiner relied upon the following prior art as evidence in support of rejections:

Britt	US Pub. 2002/0032785 A1	Mar. 14, 2002
Whitledge	US 6,925,595 B1	Aug. 2, 2005
Mitsugi	US 2002/0113817 A1,	Aug. 22, 2002

Applicant's Admitted Prior Art (Mitsugi) (hereinafter "AAPA")

The Rejections

The following rejections are before us for review:

Claims 1-5, 7-11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Britt in view of Whitledge.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Britt in view of Whitledge, and further in view of AAPA.

II. ISSUES

Has the Appellant shown that the Examiner erred in determining that the combination of Britt and Whitledge discloses a separate conversion server disposed between a portal server and a content server?

Has the Appellant shown that the Examiner erred in determining whether one skilled in the art would be motivated in combining the teachings of Britt and Whitley?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Appellant has the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any the differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In determining obviousness, the Supreme Court states:

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

The Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

VI. FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

1. Britt discloses a conversion module in the portal server 110. The conversion module receives the content from Internet sites and converts the information from one format such as HTML to another such as JAVA byte-codes for display of wireless terminals (Britt, ¶ [0034-0037]; Fig. 3).
2. Whitledge discloses a content converter 16 including a content conversion interface 110 between the portal server (proxy server 14) and converter 46 and transaction manager 44 (Whitledge, Fig. 3 and 5; col. 15, ll. 34-53).
3. Whitledge also discloses that the converter 46 invokes the client component to retrieve the electronic documents from a desired document server on internet and the content converter 16 receives the response data-body and the response metadata object (the content of the electronic

document) from the converter 46 (Whitledge, Figs. 4A-4C; col. 14 ll. 37-62).

4. Whitledge further discloses the benefit of using the separate converter (Whitledge, Abstract).

V. ANALYSIS

The Examiner has set forth a detailed explanation of a prima facie case for obviousness in the Examiner's Answer. Therefore, we look to the Appellant's Briefs to show error in the proffered prima facie case.

With respect to claim 1, the Appellant contends that Britt's content conversion module is included in the portal server 110, and thus, no separate content conversion server is disclosed (App. Br. 8-9).

We agree with the Appellant with respect to the lack of a separate content conversion server in the Britt reference (FF 1). We, however, find that Whitledge expressly teaches that a separate content converter (server) is connected to the proxy server (the portal server) (FF 2).

The Appellants further contends that Whitledge fails to disclose "a separate conversion/formatting server as claimed by Appellant" and "a specific communication link between the conversion/formatting server and one or more portal servers and also between the conversion/formatting server and a content server." (App. Br. 10.)

We disagree with the Appellant's contentions. We find Whitledge expressly discloses the argued limitations (FF 3). It is clear to us that the interface 110 of content converter 16 serves as the specific communication link between the portal server 14 and the content converter 16 (FF 3). The converter 46 and the client component 48 also serve as the part of communication link between the content converter 16 and the content server

(desired electronic document server) (FF 3).

The Appellant further contends that: (1) “[t]here is no suggestion or teaching to modify Britt’s system to perform conversion outside the portals.” (App. Br. 12) and “it makes no sense to add additional conversion servers in Britt’s system when conversion is already performed at the portal server 110.” (*Id.* at 13.) (2) “[T]he combination does not teach the specific claimed interaction between at least the three separately claimed server. Furthermore, neither of the references teach or suggest [sic] a separate content server.” (App. Br. 14.) (3) “In essence the Examiner is making a leap of faith which is merely conclusory and based on hindsight in reaching the claimed features by using the combination teachings of Britt and Whitledge.” (Reply Br. 3.)

We disagree with the Appellant’s contentions. We find that Britt discloses the portal server including a content converter (FF 1) and Whitledge discloses a content converter disposed between a portal server and a content server (FF 2 and FF 3). The combination of those familiar elements is “likely to be obvious when it does no more than yield predictable results.” *KSR*, 550 U.S. at 416. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 415, 417. In the instant case, the combination of separate content converter of Whitledge with the system of Britt yields a predictable use of them to “allow a user to extract only desired display information . . . and convert the display information into a format different than that defined for original electronic document.” (FF 4.) The combination of Britt and Whitledge is “a design step well within the grasp of a person of ordinary skill in the relevant

art and that the benefit of doing so would be obvious.” *KSR*, 550 U.S. at 401. As noted above, the motivation to combine can be found in Whitledge expressly. Thus, even though the Examiner’s motivation statement may be similar to the Appellant’s Specification, in our opinion, it is not based on impermissible hindsight.

Accordingly, we sustain the Examiner’s obviousness rejection of the independent claim 1. The Appellant advanced similar arguments with respect to dependent claims 2-7. Hence, we also sustain the Examiner’s obviousness rejection of the dependent claims 2-7. Dependent claims 13-19, which are not separately argued, fall with the base claims. 37 C.F.R. § 41.37(c)(1)(vii) (2008); *In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

VI. CONCLUSION

We conclude that the Appellant has not shown the Examiner erred in determining the combination of Britt and Whitledge discloses a separate conversion server disposed between a portal server and a content server.

We also conclude that the Appellant has not shown that the Examiner erred in determining whether one skilled in the art would be motivated in combining the teachings of Britt with Whitledge.

VII. ORDER

We affirm the rejection of claims 1-13 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R.

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§ 1.136(a)(1)(iv).

AFFIRMED

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